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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,371	10/02/2001	Noel Tenorio	020431.0917	1757
53184 7590 05/18/2007 i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			EXAMINER	
			CHANDLER, SARA M	
ART UNIT		PAPER NUMBER		
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05/18/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/970,371	TENORIO, NOEL
	Examiner Sara Chandler	Art Unit 3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 March 2007.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-29 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's arguments and request for continued examination of 09/970,371 (10/02/01) filed on 03/28/07.

### ***Information Disclosure Statement***

The information disclosure statement filed 11/28/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specifically, copies of the NPL references O and U on the IDS are missing.

### ***Claim Interpretation***

The claims have been given their broadest reasonable interpretation in accordance with MPEP § 2111.

Furthermore, the claims have been analyzed in accordance with MPEP § 2106.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. MPEP § 2106 II C.

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or

(D) "whereby" clauses.

MPEP § 2106 II C.

Re Claims 1 and 28:

Thus as described in MPEP § 2106 II C supra, for the system of the claimed invention the discrete structural elements considered in a determination of patentability are:

an electronic marketplace operable to/means for receive offer data for a plurality of offers; and

a market server operable to/ means for generate a display of the received offer data

Re Claims 10 and 19:

Thus as described in MPEP § 2106 II C supra, for the method and software embodied on computer readable media of the claimed invention the steps or acts to be performed considered in a determination of patentability are:

receiving offer data for a plurality of offers; and

generating a display of the received offer data.

Re Claims 2-6, 11-15 and 20-24:

Thus as described in MPEP § 2106 II C supra, the dependent system/method/software embodied on computer readable media claims are not entitled to patentable weight. The "wherein" clause raises the question as to the limiting effect of the language in the claim and upon close analysis it is apparent that the respective claims do not further limit the claim to a particular structure and/or they do not require steps or acts to be performed.

Re Claims 7:

Thus as described in MPEP § 2106 II C supra, for the system of the claimed invention the discrete structural elements considered in a determination of patentability are:

the electronic marketplace is further operable to access a user request; and the market server is further operable to generate within the display a pattern representing the user request.

Re Claims 16 and 25:

Thus as described in MPEP § 2106 II C supra, for the method and software embodied on computer readable media of the claimed invention the steps or acts to be performed considered in a determination of patentability are:

accessing a user request; and

generating within the display a pattern representing the user request.

Re Claims 8-9,17-18 and 26-27:

Thus as described in MPEP § 2106 II C supra, for the dependent system/method/software embodied on computer readable media claims the limitations considered in the determination of patentability are able to:

receive a selection of a particular pattern associated with a particular offer;

receive an instruction to generate an order based on the values for the offer associated with the selected pattern;

in response to receiving the instruction, automatically generate an order based on the values for the offer associated with the selected pattern; and

communicate the generated order for matching with the selected offer. (As described in

Claims 8,17 and 26)

and

display the values specified in the user request and the values specified in the user request and the values specified in the offer associated with the selected pattern to allow the user to compare these values before providing an instruction to generate an order. (As described in claims 9,18 and 27.)

Re Claim 29: The is interpreted under the same rationale as applied to claims 1,2 and 7.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claims 1,10 19 and 29: The claim recites the limitation "electronic marketplace" What is this? Please define. Is it meant to be a structural element of a system? How can a "marketplace" be operable to receive?

Re Claims 2,11 and 20: The terms "readily visually distinguishable" and "substantially similar" are relative term which renders the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Re Claims 7, 16 and 25: The claims recite "such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision." The language has not been given patentable weight because it presents actions that are to be undertaken by a user, yet whether the user undertakes these actions is optional and thus there is no guarantee that the user will do it.

Re Claims 9, 18 and 27: The claims recite "to allow the user to compare these values before providing an instruction to generate an order." The language has not been given patentable weight because it presents actions that are to be undertaken by a user, yet whether the user undertakes these actions is optional and thus there is no guarantee that the user will do it.

Dependent claims are rejected based on the same rationale as the claims from which they depend.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-3,5-9,10-12,14-18, 19-21, 23-27,28 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal, US Pat. No. US Pub. No. 2002/0032637.

**Re Claims 1-3,5-9,10-12,14-18, 19-21, 23-27,28 and 29:**

Moshal discloses a system/method/software embodied in computer-readable media for providing visualization of market offers, comprising: an electronic marketplace operable to/ means for/ receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]); and a market server operable to/ means for/ generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and particular offer variables and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, values for the offer variables (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] plurality offers (e.g., bid/ask, seller/buyer), plurality of offer variables (e.g., #items, type, user, price, length of participation etc.)).

Moshal fails to explicitly disclose:

a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar.

**Examiner Note:** Thus, the only difference between Moshal and the claimed invention is that the pattern comprises: a plurality of bars, each bar representing a particular offer variable.

In light of Moshal, the claimed invention would have been obvious based on any one of the following rationales:

Official Notice

Official Notice is taken that it was old and well-known at the time of the invention to provide a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar.

Examiner notes, that the display represents a user interface. It was old and well-known at the time of the invention that a user interface provides for the presentation of information to the users and the capture of their inputs.

Documentary Evidence:

"Microsoft Press Computer Dictionary Third Edition," editor: Kim Fryer. Copyright 1997 by Microsoft Corporation. Pg. 488;  
Pearson Education. Copyright 2001 by Addison-Wesley. Pg. 11; and  
Free On-line Dictionary of Computing. Copyright 1993-2007 Denis Howe.

Examiner further notes, that it was old and well-known at the time of the invention to manipulate the presentation of the information in a variety of ways in accordance with the preferences of a particular user. These presentations included the use of patterns incorporating bars, columns, grids etc. For example, Excel programs have been used frequently in reports, slide shows and presentations to show diagrams in the form of bars, lines and other visual forms.

**Documentary Evidence:**

"Mastering Excel 4 For Windows," by Carl Townsend. Copyright 1992 by Sybex.

Chapter 20, pgs. 423-454.;

Levine, US Pub. No. 2002/0178105 - Fig. 6 ;

Lee, US Pub. No. 2002/0065762 - Figs. 5-14; [0030] [0056]; and

Russell, US Pat. No. 7,020,630 - Fig. 8

See also MPEP § 2144.03.

**Design Choice**

Design choice is a **conclusion** reached by the Examiner regarding the difference between the claims and the prior art. This conclusion is based on a two prong test involving an analysis of **the totality of the record** including applicants own specification, and an analysis of whether the prior art would **perform equally as well** as the claimed subject matter.

A rejection based on design choice does not require that a reference expressly or even impliedly teach the difference between the claims and the prior art.

Applicant provides the following in the Specification:

Business transactions are increasingly taking place over the Internet and other electronic communication networks. Electronic markets may provide a forum for such transactions, allowing buyers to locate sellers, and vice versa. This process may involve a buyer (or seller) identifying one or more suitable offers to sell (or buy) from one or more sellers (or buyers). **However, it may be difficult for a buyer (or seller) to identify suitable offers to sell (or buy) from among the offers available to the buyer (or seller) for a number of reasons.** For example, there may be a relatively large amount of information for a buyer (or seller) to consider when trying to identify suitable offers to sell. The market may include a relatively large number of offers. Offers may include a number of variables, and there may be a relatively large number of possible values for each variable. **Additionally, there may be no available offers providing a substantial match with a particular order from the buyer (or seller). The buyer (or seller) may therefore have to determine which of the available offers provide a relatively close match with that order, taking into account a number of offer variables and possibly the relative priorities of such variables.**

Applicant' Specification, pg. 2 (10/02/01).

What is not made apparent from the record however, is how the particular visual patterns of the claimed invention resolves any problem, provides any advantage or is used for any purpose above and beyond what the visual patterns of the prior art can do equally well.

The visual patterns of Moshal perform equally well at identifying suitable offers to sell (or buy) for the offers available to the buyer (or seller); and enabling the buyer (or seller) to discern which offers prove the closest match to a particular order. That is, factors such as whether it is a offer, user request or order is distinguished; the price; the size; whether a user is a buyer or seller, the length of time a user has been in the marketplace; whether orders and offers are close to a match or consummating a transaction etc. are readily apparent from the visual pattern of Moshal. See Moshal, abstract, Figs. 1-18; [0001] – [0047]).

Examiner notes, whether presented as circles, bars, stars or any other visual pattern, the same problem could be resolved, the same advantage achieved, and purpose addressed. The fact that Applicant provides a pattern comprising a plurality of bars, each bar representing a particular offer variable is not the basis for a patentability determination. If that were the case, an infinite number of patents could be issued representing the offer and the offer variables as lines, or arrows or any other symbol and none would be any less obvious in light of Moshal.

See also *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)

Nonfunctional Descriptive Material

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106.01.

Examiner notes that "a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar" is interpreted as a compilation or mere arrangement of data. The visual pattern of the data does not provide a functional interrelationship, and is considered to be non-functional descriptive material and not entitled to patentable weight.

See also *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983).

Thus, based on any of the above rationales, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal to provide a system/method/software embodied in computer-readable media for providing visualization of market offers further comprising: a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar

As suggested by Moshal, users should have access to an easily understandable version of a the current state of critical data and any objects other than circles could be used to represent the buyers and sellers (and inherently, their respective offers also). (Moshal, abstract, [0003] [0006] [0027]).

**Re Claims 7,16 and 25:** Moshal discloses a system/method/software, wherein: an electronic marketplace is further operable to/ means for/ access a user request, the user request comprising a plurality of entered values for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]); and a market server is further operable to/ means for/ generate within the display a pattern representing the user request, the pattern for the user request comprising particular offer variables and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined scheme, entered values for the offer variables, such that a user may compare the pattern for the

user request with the patterns for one or more offers in connection with a market decision (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] (e.g., bid/ask, seller/buyer).

Moshal fails to explicitly disclose:

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision.

**Examiner Note:** Thus, the only difference between Moshal and the claimed invention is that the pattern comprises: a plurality of bars, each bar representing a particular offer variable.

In light of Moshal, the claimed invention would have been obvious based on any one of the following rationales:

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an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision."

Examiner notes, that the display represents a user interface. It was old and well-known at the time of the invention that a user interface provides for the presentation of information to the users and the capture of their inputs.

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Pearson Education. Copyright 2001 by Addison-Wesley. Pg. 11; and  
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Russell, US Pat. No. 7,020,630 - Fig. 8

See also MPEP § 2144.03.

Design Choice

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Business transactions are increasingly taking place over the Internet and other electronic communication networks. Electronic markets may provide a forum for such transactions, allowing buyers to locate sellers, and vice versa. This process may involve a buyer (or seller) identifying one or more suitable offers to sell (or buy) from one or more sellers (or buyers). **However, it may be difficult for a buyer (or seller) to identify suitable offers to sell (or buy) from among the offers available to the buyer (or seller) for a number of reasons.** For example, there may be a relatively large amount of information for a buyer (or seller) to consider when trying to identify suitable offers to sell. The market may include a relatively large number of offers. Offers may include a number of variables, and there may be a relatively large number of possible values for each variable. **Additionally, there may be no available offers providing a substantial match with a particular order from the buyer (or seller).** The buyer (or seller) may therefore have to determine which of the available offers provide a relatively close match with that order, taking into account a number of offer variables and possibly the relative priorities of such variables.

Applicant' Specification, pg. 2 (10/02/01).

What is not made apparent from the record however, is how the particular visual patterns of the claimed invention resolves any problem, provides any advantage or is

used for any purpose above and beyond what the visual patterns of the prior art can do equally well.

The visual patterns of Moshal perform equally well at identifying suitable offers to sell (or buy) for the offers available to the buyer (or seller); and enabling the buyer (or seller) to discern which offers prove the closest match to a particular order. That is, factors such as whether it is a offer, user request or order is distinguished; the price; the size; whether a user is a buyer or seller, the length of time a user has been in the marketplace; whether orders and offers are close to a match or consummating a transaction etc. are readily apparent from the visual pattern of Moshal. See Moshal, abstract, Figs. 1-18; [0001] – [0047]).

Examiner notes, whether presented as circles, bars, stars or any other visual pattern, the same problem could be resolved, the same advantage achieved, and purpose addressed. The fact that Applicant provides a pattern comprising a plurality of bars, each bar representing a particular offer variable is not the basis for a patentability determination. If that were the case, an infinite number of patents could be issued representing the offer and the offer variables as lines, or arrows or any other symbol and none would be any less obvious in light of Moshal.

See also *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)

Nonfunctional Descriptive Material

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106.01.

Examiner notes that "generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision" is interpreted as a compilation or mere arrangement of data. The visual pattern of the data does not provide a functional interrelationship, and is considered to be non-functional descriptive material and not entitled to patentable weight.

See also *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983).

Thus, based on any of the above rationales, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal to provide a system/method/software embodied in computer-readable media for providing visualization of market offers further comprising: generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision.

As suggested by Moshal, users should have access to an easily understandable version of a the current state of critical data and any objects other than objects other than circles could be used to represent the buyers and sellers (and inherently, there respective offers also). (Moshal, abstract, [0003] [0006] [0027]).

**Re Claims 8,17 and 26:** Moshal discloses system/method/software, wherein the market server is further operable to:

receive a selection of a particular pattern associated with a particular offer (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features);

receive an instruction to generate an order based on the values for the offer associated with the selected pattern (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features);

in response to receiving the instruction, automatically generate an order based on the values for the offer associated with the selected pattern (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features); and

communicate the generated order for matching with the selected offer (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features).

**Re Claims 9, 18 and 27:** Moshal discloses a system/method/software, wherein the market server is further operable to display the values specified in the user request

and the values specified in the offer associated with the selected pattern to allow the user to compare these values before providing an instruction to generate an order (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features).

**Re Claim 29:**

Moshal discloses a system for providing visualization of market offers, comprising:  
an electronic marketplace operable to:  
receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]); and  
access a user request, the user request comprising a plurality of entered values for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]); and  
a market server operable to:  
generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and particular offer variables and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, values for the offer variables, the predefined encoding scheme being selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric

display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] plurality offers (e.g., bid/ask, seller/buyer), plurality of offer variables (e.g., #items, type, user, price, length of participation etc.)); and

generate within the display a pattern representing the user request, the pattern for the user request comprising particular offer variables and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined scheme, entered values for the offer variables, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] (e.g., bid/ask, seller/buyer).

Moshal fails to explicitly disclose:

a market server operable to:

generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric

display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision.

**Examiner Note:** Thus, the only difference between Moshal and the claimed invention is that the pattern comprises: a plurality of bars, each bar representing a particular offer variable.

In light of Moshal, the claimed invention would have been obvious based on any one of the following rationales:

Official Notice

Official Notice is taken that it was old and well-known at the time of the invention to "generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more

geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision."

Examiner notes, that the display represents a user interface. It was old and well-known at the time of the invention that a user interface provides for the presentation of information to the users and the capture of their inputs.

Documentary Evidence:

"Microsoft Press Computer Dictionary Third Edition," editor: Kim Fryer. Copyright 1997 by Microsoft Corporation. Pg. 488;  
Pearson Education. Copyright 2001 by Addison-Wesley. Pg. 11; and

Free On-line Dictionary of Computing. Copyright 1993-2007 Denis Howe.

Examiner further notes, that it was old and well-known at the time of the invention to manipulate the presentation of the information in a variety of ways in accordance with the preferences of a particular user. These presentations included the use of patterns incorporating bars, columns, grids etc. For example, Excel programs have been used frequently in reports, slide shows and presentations to show diagrams in the form of bars, lines and other visual forms.

**Documentary Evidence:**

"Mastering Excel 4 For Windows," by Carl Townsend. Copyright 1992 by Sybex.

Chapter 20, pgs. 423-454.;

Levine, US Pub. No. 2002/0178105 - Fig. 6 ;

Lee, US Pub. No. 2002/0065762 - Figs. 5-14; [0030] [0056]; and

Russell, US Pat. No. 7,020,630 - Fig. 8

See also MPEP § 2144.03.

**Design Choice**

Design choice is a **conclusion** reached by the Examiner regarding the difference between the claims and the prior art. This conclusion is based on a two prong test involving an analysis of **the totality of the record** including applicants own specification, and an analysis of whether the prior art would **perform equally as well** as the claimed subject matter.

A rejection based on design choice does not require that a reference expressly or even impliedly teach the difference between the claims and the prior art.

Applicant provides the following in the Specification:

Business transactions are increasingly taking place over the Internet and other electronic communication networks. Electronic markets may provide a forum for such transactions, allowing buyers to locate sellers, and vice versa. This process may involve a buyer (or seller) identifying one or more suitable offers to sell (or buy) from one or more sellers (or buyers). **However, it may be difficult for a buyer (or seller) to identify suitable offers to sell (or buy) from among the offers available to the buyer (or seller) for a number of reasons.** For example, there may be a relatively large amount of information for a buyer (or seller) to consider when trying to identify suitable offers to sell. The market may include a relatively large number of offers. Offers may include a number of variables, and there may be a relatively large number of possible values for each variable. **Additionally, there may be no available offers providing a substantial match with a particular order from the buyer (or seller). The buyer (or seller) may therefore have to determine which of the available offers provide a relatively close match with that order, taking into account a number of offer variables and possibly the relative priorities of such variables.**

Applicant' Specification, pg. 2 (10/02/01).

What is not made apparent from the record however, is how the particular visual patterns of the claimed invention resolves any problem, provides any advantage or is used for any purpose above and beyond what the visual patterns of the prior art can do equally well.

The visual patterns of Moshal perform equally well at identifying suitable offers to sell (or buy) for the offers available to the buyer (or seller); and enabling the buyer (or seller) to discern which offers prove the closest match to a particular order. That is, factors such as whether it is a offer, user request or order is distinguished; the price; the size; whether a user is a buyer or seller, the length of time a user has been in the marketplace; whether orders and offers are close to a match or consummating a transaction etc. are readily apparent from the visual pattern of Moshal. See Moshal, abstract, Figs. 1-18; [0001] – [0047]).

Examiner notes, whether presented as circles, bars, stars or any other visual pattern, the same problem could be resolved, the same advantage achieved, and purpose addressed. The fact that Applicant provides a pattern comprising a plurality of bars, each bar representing a particular offer variable is not the basis for a patentability determination. If that were the case, an infinite number of patents could be issued representing the offer and the offer variables as lines, or arrows or any other symbol and none would be any less obvious in light of Moshal.

See also *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)

#### Nonfunctional Descriptive Material

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106.01.

Examiner notes that " generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the

first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision." is interpreted as a compilation or mere arrangement of data. The visual pattern of the data does not provide a functional interrelationship, and is considered to be non-functional descriptive material and not entitled to patentable weight.

See also *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983).

Thus, based on any of the above rationales, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal to provide a system for providing visualization of market offers comprising a market server further operable to:

generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding

to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision.

As suggested by Moshal, users should have access to an easily understandable version of a the current state of critical data and any objects other than objects other than circles could be used to represent the buyers and sellers (and inherently, their respective offers also). (Moshal, abstract, [0003] [0006] [0027]).

**Claims 4,13 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal as applied to claims 1,10 and 19 above, and further in view of Reamer, US Pub. No. 2002/0194104.

**Re Claims 4,13 and 22:** Moshal fails to explicitly disclose system/method/software, wherein a user is a buyer and the offers comprise asks only from sellers on an

approved vendor list (AVL). Official Notice is taken that it is old and well-known for buyers and sellers to limit their business transactions to preferred parties. Specifically, it was old and well known to provide wherein a user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL). For example, preferred lists are used in auctions, shopping, online transactions etc. (Reamer, abstract; [0016] [0018] [0021]; claims 2,3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal by adopting the teachings of Reamer to provide system/method/software, wherein the user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL).

One would have been motivated to avoid fraud, maintain business related and facilitate a more efficient experience.

#### ***Response to Arguments***

Applicant's arguments filed have been fully considered but they are not persuasive..

#### **Information Disclosure Statement**

It is unclear what reference has been submitted that the applicant would like to have considered.

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The premise of the rejection given is drawn to two concepts: The claims are to be given their broadest reasonable interpretation and thus not all language in the claims are entitled to patentable weight. See discussion supra. See MPEP § 2111, 2106.; and

The claimed invention is obvious in light of Moshal because the rationales of Official Notice, Design Choice and Nonfunctional descriptive material. See discussion supra.

Documentary evidence of the Official Notice taken is on the record, and corresponding bibliographic information can be found supra and in prior Office Actions.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As discussed supra the knowledge generally available to one of ordinary skill in the art was such that the claimed invention would have been obvious in light of Moshal.

Furthermore, as suggested by Moshal, users would have been motivated to have access to an easily understandable version of the current state of critical data and any objects other than circles could be used to represent the buyers and sellers (and inherently, their respective requests/offers also). (Moshal, abstract, [0003] [0006] [0027]). Examiner notes, that Moshal provides that there is a need to provide data pertaining to an electronic marketplace in a format that is easy to understand. Thus, Moshal provides for the representation of the various players in the marketplace (i.e., buyers/sellers) and the attributes of their requests/offers in visual pattern. Moshal goes on to suggest that visual patterns other than those disclosed in Moshal could also be

used to represent the buyers/sellers (and inherently their respective requests/offers also).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Jagdish Patel* 5/14/07  
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PRIMARY EXAMINER

SMC